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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,667	02/08/2002	Kathy K. Wang	OSTEONICS 3.0-380	4016
530	7590	08/23/2005	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			ROBERT, EDUARDO C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/071,667

Applicant(s)

WANG ET AL.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8-18,79,82-98 and 101-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 82-98 and 101 is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8-10 and 14-17 is/are rejected.
- 7) ☒ Claim(s) 11-13,18,79,102 and 103 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

In claim 82 there exists an inconsistency between the language in the preamble and that of the body of the claim, thus making the scope of the claim unclear. In the preamble, line 1, applicant recites "A porous metal scaffold" with the implantable medical device being only functionally recited, i.e. "for an implantable medical device ...", thus indicating that the claim is directed to the subcombination, "A porous metal scaffold". However, in lines 4-5, applicant positively recites the medical device as part of the invention, i.e. "a tissue contacting surface of the medical device ...", thus indicating that the combination, scaffold and medical device, is being claimed. As such, it is unclear whether applicant intends to claim the subcombination or combination. Applicant is hereby required to indicate to which, combination or subcombination, the claim is intended to be directed, and amend the claim such that the language thereof is consistent with this intent. For examination purposes claims 82-97 will be considered as being drawn to the combination, scaffold and medical device.

**It is noted that applicant is advised to amended claim 82, line 1 to recite "A porous metal scaffold in combination with an implantable medical device" if applicant's intention is to claim the combination.**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6 rejected under 35 U.S.C. 102(b) as being anticipated by Park et al. (U.S. Patent No. 5,441,919).

Park et al. teaches a porous metal scaffold comprising: a porous metal foam network (column 6) having an open cell structure wherein the openings of each cell are formed by metal webs (definition of Foam in column 5), at least some of the webs covered with at least one layer of metal particles (support coating of column 7 and particularly line 16 “very fine aluminum powder”), the metal particles being bonded to the metal webs, wherein said metal webs form a continuous inner skeleton of said porous metal scaffold and the size of the cell openings *may* be varied by bonding additional layers of metal particles to said at least one layer. With regard to the method step of sintering the metal particles to the webs and to varying the cell openings by changing a size of the metal particles, it is noted that the device of Park et al. appear to be substantially identical to the device claimed, although produce by a different process, therefore the burden is upon the applicant to come forward with evidence establishing an unobvious difference between the two. In re Marosi, 218 USPQ 289 (Fed. Cir. 1983).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al. (U.S. Patent No. 5,441,919).

Park et al. disclose the claimed invention except the pore size ranges from 100 microns to 1000 microns with a plurality of pores having a size greater than about 100 microns. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the webs of Park et al. such that the pore size ranged from 100 microns to 1000 microns with a plurality of pores having a size greater than about 100 microns, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). With regard to claim 9, it would have been further obvious to one having ordinary skill in the art at the time the invention was made to form the webs of Park such that the pore volume ranged from 50% to 90%, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). With regard to claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct scaffold of Park et al. to have a thickness of .5 mm to 5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. With regard to claim 15, it would have been further obvious to one having ordinary skill in the art at the time the invention was made to construct scaffold of Park et al. using titanium particles of a size from 40 microns to 80 microns, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. With regard to claims 16 and 17, it would have been

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further obvious to one having ordinary skill in the art at the time the invention was made to construct the scaffold of Park et al. with the particles or webs being titanium or titanium alloy or cobalt chrome alloy or niobium or tantalum, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant argument about suggestions for the combination/subcombination problem, it is noted that applicant's attention is directed to the section of "Claim Objections" wherein the examiner suggest how to solve this issue.

### ***Allowable Subject Matter***

Claims 82-98, 101, as understood, are allowed.

Claims 11-13, 18, 79, 102, 103 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719.

The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.